

Serial No. 09/855,385
Amdt. dated July 2, 2004
Reply to Office Action of April 5, 2004

Attorney Docket No. PF02177NA

REMARKS/ARGUMENTS

Claims 1 through 12 and 14 through 20 remain in this application.

Claims 1 through 5 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable by U.S. Patent No. 6,301,609 B1 to Aravamudan, et al. ("Aravamudan, et al. patent") in view of U.S. Patent Application Publication No. US 2002/0034281 A1 to Isaacs, et al. ("Isaacs, et al. publication"). Also, claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over the Aravamudan, et al. patent in view of the Isaacs, et al. publication and U.S. Patent No. 6,333,929 B1 to Drottar, et al. ("Drottar, et al. patent").

Claim 1 provides, *inter alia*, deleting an instant message intended for a mobile subscriber from a buddy if the mobile subscriber does not receive the instant message after the instant message is resent a predetermined number of times. Claim 3 provides, *inter alia*, similar language.

The above Office Action states that the Aravamudan, et al. patent fails to teach deleting an instant message intended for a mobile subscriber from a buddy if the mobile subscriber does not receive the instant message after the instant message is resent a predetermined number of times. However, the above Office Action further asserts that the Isaacs publication describes this operation at page 10, section 0094.

Applicants respectfully traverse the 35 U.S.C. §103(a) rejections of claims 1 through 7 and, in particular, Applicants disagree with the Examiner's interpretation of the Isaacs

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publication. Section 0094 on page 10 of the Isaacs publication describes a prior art presence update method in which a client sends updates to a server at regular intervals. If the client does not send an update for one minute, then the server marks the status of the client as "offline". Section 0094 describes the operation of updating of client status but does not mention or suggest any type of message deletion.

The following section, namely Section 0095, describes the behavior of the server when a client is marked as "offline", i.e., the server informs other users that the client is "offline". If the server detects that the client comes back "online", then the server may inform the other users accordingly. Not only does Section 0095 fail to describe or suggest any type of message deletion, but it leaves open the opportunity to retain messages until the client comes back "online".

Section 0041 uses the word "delete" when it states "In this embodiment, the central server would maintain a central repository of all sound messages or earcons in the system and would periodically update user's devices with the earcons as new ones were created. Similar methods may be used to delete earcons which are obsolete or unwanted." This section describes deletion of sound messages or earcons at a repository, likely due to the fact that the sound earcon has already been distributed (administered) successfully to users and become obsolete. Accordingly, Section 0041 does not describe or suggest deletion of an instant message, let alone message deletion if the mobile subscriber does not receive the instant message after the instant message is resent a predetermined number of times, as required by claims 1 and 3.

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Section 0048 describes deletion of a user and does not describe or suggest deletion of an instant message as required by claims 1 and 3.

Section 0073 of the Isaacs publication describes resending a message a predetermined number of times by a sending subscriber, in particular when no ACK is received. This section does not describe or suggest any type of message deletion. In fact, no part of the Isaacs publication teaches what will happen if X retransmissions fail, likely due to the fact that X can be a very high value, such as 50, and precautions are taken to re-send the message after very long delays (such as 2 hours as described in section 0092).

Likewise, the Drottar, et al. patent does not describe or suggest deleting an instant message, as required by claims 1 and 3. Therefore, claims 1 and 3 distinguish patentably from the Aravamudan, et al. patent, the Isaacs, et al. publication, the Drottar, et al. patent, and the combination of these patents.

Claims 2 and 4 through 7 depend from and include all limitations of independent claims 1 and 3. Therefore, claims 2 and 4 through 7 distinguish patentably from the Aravamudan, et al. patent, the Isaacs, et al. publication, the Drottar, et al. patent, and the combination of these patents for the reasons stated above for claims 1 and 3.

In view of the above, reconsideration and withdrawal of the rejections to claims 1 through 7 are respectfully requested.

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Claims 8 through 12 and 14 through 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Aravamudan, et al. patent in view of U.S. Patent No. 6,091,710 to Mawhinney ("Mawhinney patent").

Claims 8 and 20 provide, *inter alia*, queuing instant messages intended for the mobile subscriber *while the mobile subscriber is not registered with the instant message system*, and claim 20 provides, *inter alia*, similar language. The above Office Action states that the Aravamudan, et al. patent fails to teach queuing instant messages intended for the mobile subscriber while the mobile subscriber is not registered with the instant message system.

In contrast to claims 8 and 20, the Mawhinney patent describes a mobile subscriber registered with a system. In particular, communications between the nodes use the TCP protocol in the Mawhinney system. The TCP connection is established by the familiar three-way handshake that uses the SYN bit described in Mawhinney (Col. 8, lines 58-64) and to enables a node to send messages or packets to another node.

For the Mawhinney patent, successful communication of packets is shown in FIGs. 4 and 5 at times before, during and after any queuing may take place (later than packets labeled N = 1 and ACK = 1). To one having ordinary skill in the art, the Mawhinney patent shows that a connection is established between the nodes. The three-way handshake is not shown in the figures or described by the specification. Hence, at the time any queuing may take place, which must be at or after message N=1 has been sent, a connection is already established between the nodes and thus the nodes are registered. Therefore, the Mawhinney patent teaches away from a

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method and system of queuing instant messages intended for the mobile subscriber while the mobile subscriber is not registered with the instant message system, as required by claims 8 and 20.

Near the top of page 7 of the office communication, the examiner refers to an upstream node that waits for receipt of the fifth acknowledgement. The Examiner asserts that the supposed prior-art queuing is being done at the upstream node 160, which is supported by the Examiner's reference to col. 10, lines 32 through 65, of the Mawhinney patent and consistent with the upstream node sending a '*first unanswered message*'. It should be noted that the arrows directed to the right ($N=1, 2, 3$, etc.) are equivalent with the instant messages or messages of our application. The arrows directed to the left (Ack=1, etc.) are acknowledgements and are not Instant Messages.

In this context, "a first unanswered message" cannot be between the intermediate node 162 and the end-point node 164 because messages on that connection are always answered immediately. Hence, "a first unanswered message" would have to be between the upstream node 160 and the intermediate node 162. Indeed some messages, like message $N=3$, are not acknowledged or at least are not immediately acknowledged.

However, claims 8 and 20 provide, *inter alia*, that, after the first unanswered message, a buddy sends a second message intended for the mobile subscriber. The Mawhinney patent does not describe or suggest any type of buddy, let alone a buddy that sends a second message intended for a mobile subscriber, as required by claims 8 and 20.

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Claim 8 further provides, *inter alia*, facilitating connection of the mobile subscriber to the instant message system to retrieve the queued instant messages, and claim 20 provides, *inter alia*, similar language. The above Office Action states that the Aravamudan, et al. patent fails to teach facilitating connection of the mobile subscriber to the instant message system to retrieve the queued instant messages.

In contrast, the Mawhinney patent does not describe any type of node that may perform any retrieval or downloading of messages. Also, the Mawhinney patent does not describe any type of node that may perform the associated facilitation of a connection. For example, in a TCP context, facilitation of a connection is the three-way handshake, or connection establishment or synchronization discussed above. The Aravamudan, et al. patent and the Mawhinney patent, individually or in combination, do not describe or suggest this establishment, as required by claims 8 and 20. Therefore, claims 8 and 20 further distinguish patentably from the Aravamudan patent, the Mawhinney patent, and the combination of these patents.

Claims 9 through 12 and 14 through 19 depend from and include all limitations of independent claim 8. Therefore, claims 9 through 12 and 14 through 19 distinguish patentably from the Aravamudan patent, the Mawhinney patent, and the combination of these patents for the reasons stated above for claim 8.

In view of the above, reconsideration and withdrawal of the rejections to claims 1 through 12 and 14 through 20 are respectfully requested.

CONCLUSION

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No amendment made was related to the statutory requirements of patentability unless expressly stated herein. Also, no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Commissioner is hereby authorized to deduct any additional fees arising as a result of this response, including any fees for Extensions of Time, or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

It is submitted that the claims clearly define the invention, are supported by the specification and drawings, and are in a condition for allowance. Applicants respectfully request that a timely Notice of Allowance be issued in this case. Should the Examiner have any questions or concerns that may expedite prosecution of the present application, the Examiner is encouraged to telephone the undersigned.

Respectfully submitted,
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07/02/04

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